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October 14, 1964

Milton J. Wayne, Esq.
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Philip Morris Incorporated
Australian Patent Appln. 9440/61
Our file 582-338 Australia

Dear Mr. Wayne:

This is in reply to your letter of October 12, 1964, wherein you report the first Official Action in the subject case.

It is evident from the Action, and particularly paragraph 3 thereof, that the revisions to claims 2, 3 and 8 set forth in your letter of September 26, 1961, pertaining to all the corresponding foreign cases, have not been made in Australia. You will recall that claims 2, 3 and 8 were erroneous and misdescriptive, and that the revisions set out in your letter of September 26, 1961 were for the purpose of curing these deficiencies.

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Milton J. Wayne, Esq.

Page 2

October 14, 1964

It appears that many of the Examiner's criticisms will be obviated by entry of the revisions discussed above. We had thought this matter to have been taken care of in all 12 countries listed in your letter. Please determine at once whether this has been done in the countries other than Australia, and advise us of your findings.

Referring to the numbered paragraphs of the Australian Official Action:

1. We suggest as a title "Process for Selective Alkaloid Extraction".
2. It appears that the objection will be cured by revision of the claim in the manner set forth in your letter of September 26, 1961. The claim as revised is then supported by the specification at page 10, line 20 et seq.
(Please note that this is not part of Example VII.)
3. The part of the claim objected to is cancelled by the revision set forth in your letter of September 26, 1961. Entry of the revision will obviate the rejection.
4. We should prefer to avoid amendment of the claim, and would point in support of use of the word "about" to the paragraph commencing at page 5, line 8 of the

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Milton J. Wayne, Esq.

Page 3

October 14, 1964

specification. In stating the range of 4.0 to 7.0, it is taught that a pH on either side of this range may in particular instances be found desirable. There is further reference to a pH "below about 4.0". If deletion of "about" is necessary to avoid the criticism of ambiguity, however, you are authorized to cancel that expression.

5. We have difficulty with this objection, since claims 7 and 9 do not claim removal of nicotine only from tobacco. It seems to us that the Examiner is reading in a limitation which does not appear in the claim and, as you have observed, the specification does refer to nicotine as such (e.g., page 11, lines 5 through 9). We accordingly suggest bringing these matters to the attention of the Examiner; should he persist in his view however, we would be willing to amend the two claims to change "nicotine" to --alkaloid--.

6. Your letter indicates that you will take care of this objection. We assume that you will not cancel the claim.

Please send us a copy of the response to the Official Action in due course.

Very truly yours,

William H. Vogt III

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